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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,813	10/05/2000	Steven A. Lapierre	052144-5001	8794

9629 7590 01/20/2004
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

SNAPP, SANDRA S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,813

Applicant(s)

LAPIERRE, STEVEN A.

Examiner

Sandra Snapp

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-19 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

Drawings

The drawings remain objected to because the use of color photographs requires a petition and associated fee which has not been filed in this application. As such, the Examiner maintains that the drawings are considered informal and while may be used for examination purposes, the application cannot be allowed with informal drawings. In order for the currently filed drawings to be accepted for issuance purposes, the petition and fee must be paid, or black and white drawings should be submitted.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As stated in the previous office action, the claims must specify some form of technology. Since claims 1-11 lack any reference to specific technology, they are considered as being directed to non-statutory subject matter. The Board of Patent Appeals and Interferences took the position that claim language should be tied to some form of technological art in the case *Ex parte Bowman*. The “claimed invention . . . is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*,

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61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). While the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 112

The rejection of claims 1-19 as being indefinite under 35 U.S.C. 112, second paragraph, has been successfully overcome and is herein withdrawn.

Claim Rejections - 35 USC § 102

The rejection of claims 1-19 has been overcome with the newly amended claim language.

Response to Arguments

With regard to the rejection maintained based on 35 U.S.C. 101, Applicant has not amended the claims to include any language directed to technology. While they have taken the position that the method is for an “online trading assets via transactionally linked virtual markets” they have not yet identified any specific technology to support such an online system. They state that “online trading refers to electronic trading of assets through computer systems” and as such should amend the claims to include such limitation.

Allowable Subject Matter

Claims 12-19 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not show, disclose or teach a trading system that can optionally define

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cross-market trading strategies that will span at least two virtual markets and that define relationships between virtual markets, and automatically matching and executing both individual orders and orders generated by cross-market trading strategies for virtual markets, in such a way that atomic execution of cross-market trading strategies is guaranteed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

SS 



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600